



10-16-06

1P01 AIF/3683

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/662,662
Filing Date: September 15, 2003
Appellant(s): Simon Anne de Molina, et al.

Michael J. Schmidt

For Appellants

APPELLANTS' REPLY BRIEF

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In response to the Examiner's Answer mailed September 27, 2006, please consider the following.

The Examiner's position as given on page 4 of his Answer is that the claim language of Ergun broadly recites that each single direction rebound valve, and each single direction compression valve actuates at a different individually valve opening pressure, this language is broadly interpreted as merely requiring that each valve is capable of being adjusted to a different opening pressure.

Claim 1 recites:

"and a series of identically dimensionally configured valve assemblies positioned within said valve assemblies, a first series of said valve assemblies passing said hydraulic fluid under pressure from said recoil chamber to said compression chamber, a second series of valve assemblies passing said hydraulic fluid under pressure from said compression chamber to said recoil chamber."

Applicants find absolutely no support for the Examiner's position that this language recites that each valve actuates at a different pressure. Applicants believe quite the opposite is recited in this claim language. The claim language recites a series of identically dimensionally configured valve assemblies. Applicants believe this language clearly indicates that the valves open at the same pressure.

Applicants' position is clearly supported in column 6, lines 42-47 where Ergun states that the structure of the piston assembly 28 is advantageous in its interchangeability of components. Valve components are easily assembled and located in the valve halves. Thus, the Examiner's position has no support in the claim language and the Examiner's position also goes against the teachings and advantages of Ergun by destroying the interchangeability of Ergun.

The Examiner supports his position by referring to column 5, lines 46-47. Here, Ergun states that "All the valve heads, valve plates and valve spring clips are identical. Valve springs and pins can be modified to effect the desire damping characteristics." The Examiner states that this is broadly interpreted as providing motivation for adjusting each valve to actuate at a different individually adjustable opening pressure to provide the sequential valve opening.

While Applicants agree with the Examiner that changing valve springs and pins will change the opening pressure of the valve, Applicants disagree with the Examiner in that this teaches to have each valve to actuate at a different pressure. The Examiner has read column 5, lines 46-47 as stating "Each valve spring and each pin can be individually modified to effect the desired damping characteristics of each valve." This is not what Ergun teaches and it goes against the teachings and advantages of Ergun which are to have interchangeability of components as discussed in Ergun in column 6, lines 42-47.

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v Garlock, Inc. 721 F. 2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert denied, 469 US 851 (1984). Here, the Examiner has clearly ignored the portions of Ergun which teach away from the different opening pressures of the present invention.

The Examiner attempts to justify his position by stating that he has merely relied upon the cited sections in Ergun to provide motivation for adjusting the opening pressure of the valve elements. Applicants agree that the valve elements of Ergun can be adjusted by changing the springs and/or pins but this statement that Ergun is merely being relied upon to show adjustable valves does not agree with the Examiner's discussion of Ergun

which is centered on each valve having different opening pressures which clearly goes against the teaching and advantages of Ergun.

The Examiner then goes to Henry-Biabaud to teach a valve element having the structural limitations recited in the claims. Henry-Biabaud discloses a single compression valve 3 and a single extension valve 3a. Each valve has three stages for opening, a bleed stage (column 2, lines 34-43), a first stage (column 2, lines 44-55), and, a second stage (column 2, line 71-column 3, line 2). The adjustability for the first and second stages is provided by nuts 4, 4a and 19, 19a, respectively.

The Examiner's position is that it would have been obvious to provide the piston assembly of Ergun with the adjustable valve unit taught by Henry-Biabaud. Providing adjustability to the valves of Ergun whether it be accomplished with different springs and pins as taught by Ergun or by adding the adjustability as taught by Henry-Biabaud still does not provide the disclosure or suggestion to have each of the rebound valves and each of the compression valves opening at different pressures or sequentially as is discussed above. The only incentive to have the different opening pressures or sequential opening is Applicants' disclosure. The use of hindsight in picking and choosing isolated elements from various pieces of prior art to solve the problems addressed by Applicants' invention is improper according to the judicial standards discussed in Applicants' Appeal Brief.

Applicants respectfully request that the rejections by the Examiner be withdrawn and the pending claims be indicated as allowable.

Respectfully submitted,

Dated: October 13, 2006

By: 

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**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/662,662
	Filing Date	09/15/2003
	First Named Inventor	Simon Anne de Molina, et al.
	Art Unit	3683
	Examiner Name	Thomas J. Williams
Total Number of Pages in This Submission	Attorney Docket Number	1316N-001683

ENCLOSURES (check all that apply)

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Harness, Dickey & Pierce, P.L.C.	Attorney Name	Michael J. Schmidt	Reg. No.	34,007
Signature					
Date	October 13, 2006				

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